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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,584	09/29/2003	Hiroshi Morikawa	243149US-2 CONT	9977
22850 7590 02/05/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/05/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/671,584

Applicant(s)

MORIKAWA, HIROSHI

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-34 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1-07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Detailed Action

Informality

There are numerous misspellings in the text of the written disclosure, especially at pages 3 and 6. Applicant should proof the specification for misspellings.

1.

Claims 18-34 and 36-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new matter is:

- a) displaying serial number of each of the selected plurality of data files;
- b) a storage device configured or which indicates data from a host machine or scanner.

2.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the a) displaying serial number of each of the selected plurality of data files;

b) a storage device configured or which indicates data from a host machine or scanner must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-9 and 18-29 are rejected under 35 U.S.C. 102(b) as being anticipated by **H.A.M. Van Oijen** (5,918,988).

With respect to claims 6, Oijen teaches a digital image forming apparatus print system 1, taught at col. 3, lines 13-21 and 25-30 comprising:

a memory 3 as the store configured to store a plurality of data (print jobs) in a stored order, see col. 6, lines 53-59;

a selective device (selection box 402) and criteria 401 of an operating screen for selecting an arbitrary desired data order for the plural data stored without regard to the storage order; a linking controller (operator interface 6) configured to link the plural data from the store into the arbitrary desired data order selected for performing an operation an operation controller 5, configured to receive the data group from the linking controller and to control the operation using the data in the data group in the arbitrary data order selected by the selection input device, see col. 3, lines 4-7.

With respect to claims 7 and 20, Oijen teaches wherein the plurality of data in the store includes image data (electronic image data, see col. 3, line 18) or document data (print jobs according to col. 10, line 21).

With respect to claim 8, Oijen teaches the operation controlled by the operation controller includes a printing job, see col. 10, lines 21.

With respect to claim 9, Oijen teaches plurality of data in store includes print job finishing conditions (finishing parameters, see col. 4, lines 43-58 and said operation includes print job finishing (i.e., fold staple and punch).

With respect to claim 18, Oijen teaches a method of printing data files (referred to as print jobs) using an image printing device, printing system 1, comprising: a memory 3 as the store configured to store a plurality of data (print jobs) in a stored order, see col. 6, lines 53-59;

a selective device (selection box 402) and criteria 401 of an operating screen for selecting an arbitrary desired data order for the plural data stored without regard to the storage order; a linking controller (operator interface 6) configured to link the plural data from the store into the arbitrary desired data order selected for performing an operation an operation controller 5, configured to receive the data group from the linking controller and to control the operation using the data in the data group in the arbitrary data order selected by the selection input device, see col. 3, lines 4-7.

With respect to claim 19, Oijen teaches selecting a number of copies (col. 8, line 4) for data files to be printed.

With respect to claim 21, Oijen teaches selecting steps performed by a user through interaction with an operation and display panel. See keyboard and mouse at col. 9, lines 60-65 and the print means according to col. 5, lines 11-15 and 42-46.

With respect to claims 22 and 28, Oijen teaches ; a linking controller (operator interface 6) configured to link the plural data from the store into the arbitrary desired

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data order selected for performing an operation an operation controller 5, configured to receive the data group from the linking controller and to control the operation using the data in the data group in the arbitrary data order selected by the selection input device, see col. 3, lines 4-7.

With respect to claims 23 and 29, Oijen teaches selecting at least one print condition including selecting at least one of stapling and punching, see col. 4, lines 43-58.

With respect to claim 24, Oijen teaches an image printing device (print system 1), comprising:

A storage device (memory 3) configured to store data files

A selection device (selection box 402 and criteria 401 of an operating screen), a plurality of the data files stored in the storage device, and to select a print start command (from an operating screen according to col. 7, lines 35-39, 42-46 and col. 8, lines 40-45; and printing device configured to print the selected plurality of data files as a single job, wherein the plurality of data files are printed in a selected order, see col. 3, line 4-7.

With respect to claim 25, Oijen teaches matrix sorting 707 as the means for selecting a number of copies of each of the plurality of data files to be printed, see col. 8, line 4.

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With respect to claim 26, Oijen teaches a scanning device (input device according to col. 2, lines 65-67 and col. 3, lines 12-17) for obtaining data files by scanning, wherein the data files include at least one of image data (col. 3, line 18) and document data (print jobs, according to col. 10, line 21)

With respect to claim 27, Oihen teaches a keyboard, mouse as the operation and control panel. See also col. 9, lines 60-65 and the print means at col. 5, lines 11-15 and 42-46.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 –17 and 30-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahlby.

With respect to claim 10, Dahlby teaches a computer program stored on a machine readable medium (RAM 56), see col. 4, line 54-57 and col. 4, lines 42-46, the computer program comprising: first program means (program stored in RAM 56) for controlling storing of a plurality of data in a storage order (memory 61, see col. 4, lines

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34-39); second program (program stored in RAM 56) for selecting an arbitrary desired data order of the plurality of data without regard to the storage order (via menu 198, see col. 7, lines 50-59); third program means (program RAM 56) for linking the stored data selected in said arbitrary desired data order to form a data group for performing an operation (col. 8, lines 1-7 where print jobs in first order are altered by designation to a job file 188 then transferred back in arbitrary print queue of queue 160); fourth program means (RAM 56 for controlling performing the operation using the data in the data group in the selected arbitrary desired order, see controller 5 as taught at col. 4, lines 18-21.

With respect to claims 11 and 15, Dahlby teaches wherein the plurality of data includes image data (col. 4, line 34) or document data (col. 4, line 35 and 47).

With respect to claims 12 and 16, this limitation is taught at col. 4, lined 35.

With respect to claims 13 and 17, Dahlby teaches the plurality of data includes print job finishing conditions (paper type, quantity of prints, as referred to at col. 6, lines 17-19) and includes print job finishings according to col. 6, lines 18-20.

With respect to claim 14, Dahlby teaches linking independent data (different print jobs) from different locations (memory addresses located in memory 61 of RAM 56) comprising:

A method of storing plural data as claimed, via program means (program stored in RAM 56) for controlling storing of a plurality of data in a storage order (memory 61, see col. 4, lines 34-39); a step of selecting an arbitrary desired order via (program stored in RAM 56) for selecting an arbitrary desired data order of the plurality of data without regard to the storage order (via menu 198, see col. 7, lines 50-59); a third step of linking via program means (program RAM 56) for linking the stored data selected in said arbitrary desired data order to form a data group for performing an operation (col. 8, lines 1-7 where print jobs in first order are altered by designation to a job file 188 then transferred back in arbitrary print queue of queue 160); a step of performing the operation via (RAM 56 for controlling performing the operation using the data in the data group in the selected arbitrary desired order, see controller 5 as taught at col. 4, lines 18-21).

With respect to claim 30, Dahlby teaches a computer program (via software having instructions stored on RAM 56 for sending instructions to an image printing device to print data files by performing the steps of :

Storing data files (image files and program print jobs, according to col. 4, lines 34-47), in a storage device associated with the image print device (system 1); selecting in an arbitrary order, via menu 198, according to col. 7, lines 50-59, a plurality of data files; selecting a print start command (via a finger touch or click of mouse 66 to select documents of a job to be printed, see col. 4, lines 38-54;

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Printing the plurality of data files as a single job (col. 4, lines 34-38, 46 and 47), wherein the plurality of data files are printed in the selected order, see col. 8, lines 1-6.

With respect to claim 31, see figure 7 under Job Type: Standard.

With respect to claim 32, the instructions for obtaining the plurality of data files by scanning (see scanner 6 at figure 2) wherein the plurality of data files include at least one of image data (according to col. 4, line 34) and document data (col. 4, lines 35 and 47).

With respect to claim 33, see figure 7.

With respect to claim 34, Dahlby teaches this claimed feature with respect to col. 7, line 50- to col. 8, line 5 where jobs can be modified in the queue with respect to their original order.

5. **Examiner's Remarks**

Applicant's remarks have been considered but are unpersuasive to allow the claims. Applicant has amended the claims to subject matter that is neither supported in the written disclosure nor illustrated in the drawings. The subject matter added by amendment received 12-11-2006 is not given patentable consideration.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Grant II